



## UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/829,558	03/28/97	MERULO	D 8105-009

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HM21/0331

EXAMINER	
BAKALYAR, H	
ART UNIT	PAPER NUMBER
1645	

DATE MAILED: 03/31/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/829,558</b>	Applicant(s) <b>Merulo</b>
	Examiner <b>Heather Bakalyar</b>	Group Art Unit <b>1645</b>



Responsive to communication(s) filed on Mar 28, 1997

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-47 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-47 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, 18-23, 27-31 drawn to viral vectors, complexes and packaging cells comprising a chimeric envelope protein-encoding sequence encoding a portion of Protein A, classified for example in class 536, subclass 23.1.
  - II. Claims 11-17, 23-26, 32-37 drawn to viral vectors, complexes and packaging cells comprising a chimeric envelope protein-encoding sequence encoding a portion of alpha virus, classified for example in class 536, subclass 23.1.
  - III. Claims , drawn to a method of expressing a gene of interest in a target cell, classified for example in class 536, subclass 23.1.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I-II, drawn to viral vectors, complexes and packaging cells are related as products. Inventions I-II are distinct, each from the other because the products comprise different chimeric envelope-encoding sequences having distinct primary sequences and encoding protein products with divergent primary, secondary and tertiary structures, with unique functional properties.
4. Inventions I-II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the cells expressing the viral vectors, complexes and packaging

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cells of Groups I-III can be used to transfer genes of interest to a eukaryotic cell, without expression of the transferred gene (e.g. transfer to disrupt expression of genes native to the transfer host).

5. These inventions are distinct for the reason given above and have acquired a separate status in the art because of their recognized divergent subject matter. Therefore, restriction for examination purposes as indicated is proper. In addition, prior art searches require non-patent literature searches. The literature search for the invention of any Group would not be expected to reveal all the relevant references for the inventions of the remaining Groups.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication should be directed to Heather Bakalyar at telephone number (703)305-7143.

The examiner can normally be reached on Monday through Friday from 9:00 am to 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

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Paula Hutzell, Ph.D., can be reached on (703) 308-4310. The official fax phone number for this Group is (703)308-4242.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1800 receptionist whose telephone number is (703)308-0196.

Heather Bakalyar, Ph.D.

3/28/98



PAULA K. HUTZELL  
SUPERVISORY PATENT EXAMINER